

### **REMARKS**

Claims 10, 11, 15, 17, 18, and 20-28 are pending in the present application. Claims 10, 27, and 28 have been amended. Claims 10, 27, and 28 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

#### ***Rejection Under 35 U.S.C. § 102***

Claims 10 and 20-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,042,594 to Dawe et al. (hereafter “Dawe”). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As amended, independent claim 10 now recites, “capturing the pixels displayed within the selected on-screen region, and storing the captured image pixels in an image file such that the image file is representative of only those pixels of the display within the selected on-screen region” (emphasis added). Thus, according to the amended claim, the context is stored in association with an image file representing only the selected on-screen region.

Conversely, Dawe’s invention receives the entire scanned image of a document, and analyzes the scanned image to find handwriting written on the original paper document. According to Dawe, text recognition is performed on the handwriting, so that the recognized text can be saved as an annotation of the scanned image of the entire document. See col. 7, lines 18-20; col. 8, lines 21-26. Even though Dawe teaches that a mouse may be used to designate a region of the document to be searched for handwriting, there is no teaching or suggestion in Dawes of producing a separate image file of only the pixels captured from this designated region.

Further, Dawe teaches that the handwriting is already on the document before scanning. See col. 1, lines 32-33; col. 3, line 66 - col. 4, line 6. Thus, Dawe does not teach or suggest applying text recognition to an annotation drawn by the user on the screen via a stylus, as claimed.

At least for the reasons set forth above, Applicants submit that independent claim 10 is allowable over Dawe. Accordingly, claims 20-23 are allowable at least by virtue of their dependency on claim 10. Therefore, reconsideration and withdrawal is respectfully requested.

***Rejection Under 35 U.S.C. § 103***

**Dawe/Oppermann**

Claims 11, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dawe in view of U.S. Patent No. 6,334,157 to Oppermann et al. (hereafter “Oppermann”). Applicants respectfully submit that Oppermann fails to remedy the deficiencies of Dawe set forth above in connection with independent claim 10. Oppermann’s invention enables an accessibility aid to directly access user interface elements of an application program in order to manipulate the user interface elements to be perceived by a disabled user (see abstract; col. 4, lines 6-39). None of Oppermann’s teachings cited by the Examiner are concerned with capturing and storing pixels of a selected on-screen region, or processing user-drawn annotations. Accordingly, Applicants submit that claims 11, 25, and 26 are allowable at least by virtue of their dependency on claim 10. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**Dawe/Browne**

Claims 15 and 18 stand rejected under § 103(a) as being unpatentable over Dawe in view of U.S. Patent Application Publication No. 2004/0135815 to Browne et al. (hereafter “Browne”). Applicants respectfully submit that Browne fails to remedy the deficiencies of Dawe set forth above in connection with independent claim 10. The Examiner relies on Browne merely for its teachings in Fig. 12 and paragraph 136 regarding the association of image files with metadata items. Accordingly, Applicants submit that claims 15 and 18 are allowable at least by virtue of their dependency on independent claim 10. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

**Dawe/Browne/Newman**

Claim 17 stands rejected under § 103(a) as being unpatentable over Dawe and Browne, and further in view of U.S. Patent Application Publication No. 2003/0101156 to Newman (hereafter "Newman"). It is respectfully submitted that Newman fails to remedy the deficiencies of Dawe (and Browne) set forth above in connection with independent claim 10. Particularly, Newman is merely relied upon for teachings related to a database system and method in which a linking structure between a stored image file and information is incorporated in a separate file. Accordingly, Applicants submit that claim 17 is allowable at least by virtue of its dependency on claim 10. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**Dawe/Saund**

Claim 24 stands rejected under § 103(a) as being unpatentable over Dawe in view of U.S. Patent Application Publication No. 20003/0182630 to Saund et al. (hereafter Saund).

Applicants submit that Saund fails to remedy the deficiencies of Dawe set forth above in connection with claim 10. For instance, Saund does not teach or suggest capturing and storing only those pixels within a selected on-screen region in an image file, as claimed.

Also, even though Saund's invention determines whether a user input gesture is a draw operation, it would not have been obvious to modify Dawe in view of Saund to allow the user to draw the annotations on the displayed scanned image via a stylus. Dawe expressly teaches that the annotations are generated based on handwriting on the original scanned document. Thus, Dawe's handwriting recognition logic 140 is only designed to analyze portions of the scanned image. Any modification of Dawe to receive user drawings via a stylus, and to apply handwriting recognition on such drawings to obtain the annotations, would change the principle of operation of Dawe's invention, which is not permitted. See MPEP § 2143.01.VI, which states:

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In view of the foregoing, Applicants submit that Saund does not remedy the deficiencies of Dawe with respect to independent claim 10. Accordingly, claim is allowable at least by virtue of its dependency on claim 10. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**Dawe/Hertzfeld**

Claims 27 stands rejected under § 103(a) as being unpatentable over Dawe in view of U.S. Patent Application Publication No. 2002/0076109 to Hertzfeld et al. (hereafter "Hertzfeld"). This rejection is respectfully traversed.

In the rejection, the Examiner admits that Dawe fails to disclose automatically determining whether the selected on-screen region includes underlying data (Office Action, paragraph bridging pages 10-11). However, the Examiner asserts that Hertzfeld teaches automatically determining whether the displayed content of the on-screen region includes underlying data comprising at least one of: an executable object, a file, and a link to remote content (Office Action at page 11). To support this assertion, the Examiner cites step 608 of Fig. 6 and paragraph 38 of Hertzfeld. Applicants respectfully disagree with the Examiner's assertion.

Hertzfeld only applies text recognition on the words selected (touched) by a user. This text recognition is performed by the interpreter 125 by parsing the selected words, as well as the surrounding words (paragraphs 0031, 0035). There is no teaching or suggestion that Hertzfeld performs the additional step of determining whether there is underlying data comprising at least one of an executable object, a file, and a link to remote content. When Hertzfeld determines that the selected text comprises a world wide address, this is merely the result of the text recognition performed by the interpreter 125. See paragraph 0038. Thus, Hertzfeld would recognize the

selected text as being a WWW address regardless of whether or not the on-screen document included a link.

Accordingly, Applicants submit that Dawe and Hertzfeld, taken separately or in combination, fail to teach or suggest the claimed feature of automatically determining whether the displayed content of the on-screen region includes underlying data comprising at least one of: an executable object, a file, and a link to remote content.

Further, with respect to the limitations “automatically extracting a character or word from the textual data as context information” and “automatically extracting a property of the underlying data as context information,” Applicants respectfully submit that conditional limitations are not optional as suggested by the Examiner -- the claim requires these limitations to be performed when specified conditions are met. Further, claim 27 clearly recites steps for determining whether the corresponding conditions are met. Thus, Applicants respectfully submit that the Examiner has erred in ignoring these limitations as being optional. However, in an effort to expedite prosecution, claim 27 has been amended to replace the “if” with “when,” thus even more clearly reciting that the claim requires each of the “automatically extracting” steps to be performed when the corresponding condition is satisfied. Since the Examiner has failed to point out any teaching or suggestion in Dawe or Hertzfeld of performing the “automatically extracting” step, Applicants submit that claim 27 is allowable.

Although Applicants believe that claim 27 is allowable at least for the reasons given above, claim 27 has been amended to further distinguish over the cited reference in an effort to expedite prosecution. Specifically, claim 27 has been amended to recite, “storing the captured pixels as an image file such that the image file is representative of only those pixels of the display within the on-screen region” (emphasis added). As discussed above in connection with claim 1, Dawe stores annotations in association with the entire image of the scanned document. Dawe does not capture and store pixels of only those pixels in the selected on-screen region. Hertzfeld does not remedy this deficiency of Dawe.

At least for the reasons set forth above, Applicants submit that claim 27 is in condition for allowance. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**Dawe/Beauchamp**

Claim 28 stands rejected under § 103(a) as being unpatentable over Dawe in view of U.S. Patent Application Publication No. 2008/0046837 to Beauchamp et al. (hereafter “Beauchamp”). This rejection is respectfully traversed.

As to the Examiner’s assertion that the “automatically extracting” steps can be ignored simply because they are performed in response to certain conditions being met, Applicants respectfully disagree. However, in an effort to expedite prosecution, Applicants have amended claim 28 to more clearly recite that the content of the on-screen region is automatically determined to include either textual data or underlying data comprising at least one of an executable object, a file, and a link to remote content. Also, claim 28 has been amended to recite, without condition, automatically extracting as context information at least one of a character or word from the textual data and a property of the underlying data. Since the Examiner has failed to point out any teaching or suggestion in Dawe or Beauchamp of this automatically extracting step, Applicants submit that claim 28 is in condition for allowance.

However, claim 28 has also been amended to recite, “storing the captured pixels as an image file such that the image file is representative of only those pixels of the display within the on-screen region” (emphasis added). For reasons discussed above in connection with claims 1 and 27, Dawe fails to teach or suggest this feature. Further, Applicants submit that Beauchamp fails to teach or suggest this feature.

At least for the reasons set forth above, Applicants submit that claim 28 is in condition for allowance. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

***Conclusion***

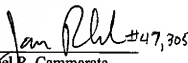
In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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